

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

REMARKS

Claim Status

Claims 1-6, 9 and 15-19 are pending in the present application. Claims 7, 8 and 10 have been canceled.

I. Objection to the Specification

The Office Action objected to informalities in the specification with the use of trademarks. The specification has been amended to capitalize all trademarks and accompany them with the generic terminology. Due to the amendments, the objection is rendered moot.

II. Claim Objections

The Office Action objected to claims 7 and 10 under 37 CFR 1.75(c), as being improper dependent claims. Claims 7 and 10 have been canceled. Thus, the objection is rendered moot.

III. Claim Rejections - 35 USC § 112

The Office Action rejected claims 6, 8 and 10 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claim 6 is rejected as being indefinite for failing to particularly point out the metes and bounds of the claim. Claim 6 has been amended to delete the modifier "about." Claim 8 and 10 have been canceled. Due to the amendments, the rejections to claim 6, 8 and 10 are rendered moot.

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

IV. Claim Rejection - 35 USC § 102

Rejection Under 35 USC §102 Over Date et al. (U.S. Patent No. 5,674,509) (hereinafter referred to as "Date")

Claims 1-3, 5, 7, 10 and 19 are rejected under 35 U.S.C §102 (b) as anticipated by Date. The Office Action states that Date teaches all of the instantly required claim limitations and is considered anticipatory.

This rejection is traversed.

The present invention relates a lathering personal cleansing composition. The lathering personal cleansing composition comprises a) from about 0.05% to about 5.0% of an alkyl ethoxylated polymer; b) from about 0.1% to about 5% of a cross-linked acid co-polymer; c) from about 0.1% to about 30% of a particulate material selected from the group consisting of a cleansing agent, exfoliating agent and mixtures thereof; and d) from about 4% to about 30% of a lathering surfactant selected from the group consisting of anionic, amphoteric and zwitterionic.

The Applicants respectfully submit that Date does not disclose each and every limitation of the claims of the present invention; therefore, Date does not anticipate the claims of the present invention. Under §102, anticipation requires that all the claim elements appear in a single prior art document. "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference" MPEP §2131 citing *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2D 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim" MPEP §2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2D 1913, 1920 (Fed. Cir. 1989). Specifically, Date does not teach a personal cleansing composition that comprises lathering surfactants. To this end, a declaration of Timothy Coffindaffer, an inventor on the above identified application has been submitted with this response. Mr. Coffindaffer states that Date describes surfactants, ARLATONE 2121, which are used to emulsify oils and set up liquid crystalline systems. These surfactants

Page 9 of 30

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

are not "lathering surfactants". Because Date does not disclose each and every element of the present application, it cannot as a matter of law anticipate the claims of the present application. Therefore, the Applicants respectfully request withdrawal of the rejection on this basis.

V. Claim Rejection - 35 USC § 103

- a. Rejection Under 35 USC §103(a) Over Date in view of Noveon (CASF-1 "Carbopol Aqua SF- Polymer" Dec. 2000 edition) as evidenced by Patel (hereinafter referred to as "Noveon").

Claims 1 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Date in view of Noveon.

The Office Action states that Date teaches the skin care composition. The Office Action states that Date does not specifically name alkali-swellaable acrylate co-polymers. Noveon teaches that CARBOPOL AQUA SF-1 for use in a clear baby shampoo formulation. The Office Action states that CARBOPOL AQUA SF-1 is useful to thicken nonionic surfactants, stabilize suspensions, retain clean formulations and enhance pearlescence formulations. The Office Action states that the BYV is about 30-50. The Office Action concludes that it would be obvious to one of skill in the art at the time of the instant invention was made to make a cleaning composition comprising alkali swellaable cross linked co-polymers, as taught by Date in view of Noveon. The Office Action states that one of ordinary skill in the art at the time the invention was made would have been motivated to combine these elements into a single composition because of the beneficial effects of CARBOPOL AQUA SF-1 in cleaning compositions as taught by Noveon. The Office Action states that absent to any evidence of the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention.

The Applicants respectfully traverse the rejection.

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

i. Proper Basis for §103(a) Rejection

The patent statute states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if such difference between the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall be not negated by the manner in which the invention was made. 35 USC §103(a)

A determination that a claim is obvious under §103(a) is a legal conclusion involving four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, or non-obviousness. *Graham v. John Deere Co.* 383 U.S. 1, 17-18 (1966). Secondary considerations of obviousness include factors such as commercial success, long-felt but unresolved needs, the failure of others, and/or unexpected results achieved by the claimed invention. *Id.* Furthermore, obviousness must be determined as of the time the invention was made and in view of the state of the art that existed at the time. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F. 2d 1044, 1050-51 (Fed. Cir 1988).

The Patent Office “has the burden under §103 to establish a prima facie case of obviousness.” *In re Fine*, 837 F. 2d 1071 1074 (Fed. Cir. 1988); MPEP §2142 (8th Ed. Rev. 6, Sept. 2007) (“the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.”). The Supreme Court recently identified a number of rationales that may be used to support a conclusion of obviousness, consistent with the framework set forth in its decision in *Graham v. John Deere Co.* (See *KSR int’l Co. V. Teleflex, Inc.* 127 S. Ct. 1727, 1739-40 (2007)). These and other representative rationales are described at MPEP § 2143 (8th Ed., Rev. 6, Sept. 2007). Regardless of the supporting rationale, however, the Patent Office must clearly articulate facts and reasons why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s filing date. (See *KSR Int’l Co. v. Teleflex, Inc.* 127 S. Ct. 1741). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness. In re Kahn, et al., 441 F. 3d 977, 988 (Fed. Cir 2006). The key to supporting any rejection under 35 USC §103 is a clear articulation of the reasons why the claimed invention would have been obvious.

In a recent case regarding the appropriate standard for establishing obviousness, the Supreme Court stated:

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense is already known.”
KSR International Co. v. Teleflex, Inc. 127 S. Ct. 1727, 1741 (2007)
emphasis added

ii. Scope and Content of Prior Art

The rejected claims rely on a specific combination of an ethoxylated polymer, cross-linked polymer, particulate material and a lathering surfactant. By using a combination of ethoxylated polymers for thickening and cross-linked polymers for suspension in the present invention, one can obtain a product that is stable as wells as lathers and rinses well.

The Date reference describes a skin care composition in the form of an oil-in-water dispersion. The composition comprises a silcon gum, a fatty acid ester and surfactants. The surfactants Date describes are used to emulsify oils and set up liquid crystalline systems. These surfactants are not “lathering surfactants”.

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

The Noveon reference relates to a clear baby shampoo. The clear baby shampoo formulation of Noveon has high levels of non-ionic surfactants and a CARBOPOL AQUA SF-1 co-polymer. Non-ionic surfactants are quite mild to the skin and eyes but non-ionic surfactants typically do not lather.

iii. The Differences between the Claimed Invention and Prior Art

One of the differences between the subject matter recited in claim 1 and the disclosures in Date and Noveon is that these references do not comprise lathering surfactant. Further, the action does not plausibly describe how this missing disclosure is otherwise taught by the art.

iv. The Rationales Purportedly Supporting a Prima Facie Case of Obviousness in the Action Do Not Apply

The action appears to support the §103(a) of all the pending claims by the rationale that all of features/elements recited in the claims were known in the prior art, and that the ordinarily skilled artisan could have combined those known features/elements, as claimed by known methods with no change in their respective functions to yield predictable results.

The Applicants respectfully submit that the action as a whole does not clearly articulate facts and reasons why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as the claimed invention effective filing date. Specifically, the action does not articulate findings of fact relating to (1) the scope and content of the prior art, and (2) the difference between the claimed invention and the prior art. Still further, while the action appears to rationale its conclusion of obviousness, the action does not articulate facts sufficient to support the asserted rationale. See MPEP 2143. The action, therefore, does not set forth a prima facie case of obviousness. Accordingly, the Applicants respectfully traverse the rejection, and request reconsideration and withdrawal of the rejection.

The Examiner has not identified a reason that would have prompted a person of ordinary skill in the relevant field to combine Date and Noveon. To this end, a declaration of Timothy Coffindaffer, an inventor on the above identified application has

been submitted with this response. Mr. Coffindaffer demonstrates in the declaration that each reference alone or in combination does not teach or suggest the present invention.

Mr. Coffindaffer states that none of the cited references, Date and Noveon, teach or suggest the advantages and benefits of the combination of an ethoxylated polymer, cross-linked polymer, particulate material and a lathering surfactant used in the present invention. Both Date and Noveon do not disclose any information about lathering surfactants. Mr. Coffindaffer states that Date describes surfactants, ARLATONE 2121, are used to emulsify oils and set up liquid crystalline systems. These surfactants are not "lathering surfactants". Mr. Coffindaffer states that Noveon teaches non-ionic surfactants which are quite mild to the skin and eyes but typically do not lather due to their inability to pack at the interface. Mr. Coffindaffer states that Noveon teaches that the acrylate copolymer (CARBOPOL AQUA SF-1) to thickening their system. Mr. Coffindaffer states in the declaration, the yield value that Noveon reports, 30 to 50 dyne/cm², is not enough to suspend insoluble materials in a lathering surfactant system. Mr. Coffindaffer concludes that the physical state of liquid crystal structure in Date does not allow the technology of Date to be combined with the micelle chemistry of the baby shampoo of Noveon. Mr. Coffindaffer further concludes that the physical state of the systems are different, the mechanisms for thickening and suspension are different. Thus, the combination of Date and Noveon would not produce the composition of the present invention.

The action also appears to support the §103(a) rejection of all of the pending claims by the rationale that the skilled artisan would have been motivated to modify the Date patent to achieve the claimed invention and that there would have been a reasonable expectation of success. See Action page 7. Specifically, the action does not articulate any findings that there was some teaching suggestion or motivation, either in the Date patent or in the knowledge available to one of ordinary skill in the art, to modify the disclosure in the Date patent to arrive at the subject matter recited in claim 1. First of all Date teaches a composition with a different physical properties than the composition of the present invention according to Mr. Coffindaffer. One skilled in the art would know that Date describes surfactants that are used to emulsify oils and set up liquid crystalline

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

systems and that these surfactants are not “lathering surfactants”. The asserted rationale supporting the §103(a) rejection does not apply, however, absent such findings. See MPEP §2143(G).

Moreover, the mere fact that the Date patent’s disclosure can be modified does not render the resultant modification obvious unless the result would have been predictable to the ordinarily skilled artisan. *See KSR Int’l S.Ct.* at 1740. Modifying the composition of Date from a leave-on moisturizer into a different physical form of lathering surfactant composition would be unexpected and unpredictable to one skilled in the art. As stated in the declaration of Mr. Coffindaffer, one of skill would never combine leave-on lotion technology, as in the Date reference with a lathering surfactant system, as claimed in the present invention. The two systems do not mix. Materials used in moisturizers will typically render a lathering system non-lathering and also destroy micelle structure. In fact, Mr. Coffindaffer concludes that the physical state of liquid crystal structure in Date does not allow the technology of Date to be combined with the micelle chemistry of the baby shampoo of Noveon. Mr. Coffindaffer further concludes that the physical state of the systems are different and thus, the mechanisms for thickening and suspension are different.

Additionally, the action does not articulate any finding that the ordinarily skilled artisan could have combined the elements, as claimed, by known methods, and that in combination each element merely performs the same function as it does separately. Specifically, the action does not articulate any finding that the ordinarily skilled artisan could have combined the composition of Date with the co-polymer of Noveon to form the present invention. The action does not present any findings that co-polymer of Noveon would perform the same function in the compositions of Date. In fact, Mr. Coffindaffer states that Noveon teaches that the acrylate co-polymer (CARBOPOL AQUA SF-1) to thickening their system. Mr. Coffindaffer states in the declaration, the yield value that Noveon reports, 30 to 50 dyne/cm², is not enough to suspend insoluble materials in a lathering surfactant system. Absent such findings, the asserted rationale supporting the §103(a) rejection does not apply.

Still further, the action does not articulate any finding demonstrating a reasonable expectation of success. Specifically, the action does not set forth any finding that a skilled artisan would have a reasonable expectation that reformulating the leave-on moisturizer of Date with the co-polymer of Noveon would not create composition as

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

recited in claim 1. In fact, Mr. Coffindaffer concludes that the physical state of liquid crystal structure in Date does not allow the technology of Date to be combined with the micelle chemistry of the baby shampoo of Noveon. Mr. Coffindaffer further concludes that the physical state of the systems are different and thus, the mechanisms for thickening and suspension are different. As stated in the Declaration of Mr. Coffindaffer, there would be no expectation of success. The asserted rationale supporting the §103(a) rejection does not apply, however, absent such findings.

Accordingly, the rejection is traversed, and the reconsideration and withdrawal of the rejection are respectfully requested.

Therefore, the Applicants respectfully disagree that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cite references to result in the compositions of the present invention. Thus, the Applicants respectfully submit that the rejection should accordingly be withdrawn.

b. Rejection Under 35 USC §103(a) Over Date in view of McKelvey et al. (U.S. Patent No. 6,589,517 (hereinafter referred to as "McKelvey")).

Claims 1, 4, 6 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Date in view of McKelvey.

The Office Action states that Date teaches the skin care composition. The Office Action states that Date does not specifically name alkali-swellable acrylate co-polymers. The Office Action states that McKelvey teaches hair care compositions and the use of alkyl ethoxylates that may be branched, linear, saturated or unsaturated. The Office Action states that these polymers are beneficial as thickeners in hair care compositions. The Office Action states that it would have been obvious to one skilled in the art at the time the invention was made to make a cleaning composition comprising di- and tri- alkyl substituted ethoxylated polymers, as taught by Date in view of McKelvey. The Office Action states that one skilled in the art would have been motivated to combine these elements into a single composition because McKelvey is in the hair composition art and exemplifies that any of the mono- di- or tri- alkyl substituted ethoxylated polymers are

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

beneficial thickeners in hair compositions. The Office Action concludes that absent any evidence to the contrary and based on the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention.

i. Proper Basis for §103(a) Rejection

The patent statute states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if such difference between the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall be not negated by the manner in which the invention was made. 35 USC §103(a)

A determination that a claim is obvious under §103(a) is a legal conclusion involving four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, or non-obviousness. *Graham v. John Deere Co.* 383 U.S. 1, 17-18 (1966). Secondary considerations of obviousness include factors such as commercial success, long-felt but unresolved needs, the failure of others, and/or unexpected results achieved by the claimed invention. *Id.* Furthermore, obviousness must be determined as of the time the invention was made and in view of the state of the art that existed at the time. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F. 2d 1044, 1050-51 (Fed. Cir 1988).

The Patent Office “has the burden under §103 to establish a prima facie case of obviousness.” *In re Fine*, 837 F. 2d 1071 1074 (Fed. Cir. 1988); MPEP §2142 (8th Ed. Rev. 6, Sept. 2007) (“the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.”). The Supreme Court recently identified a number of rationales that may be used to support a conclusion of obviousness, consistent with the framework set forth in its decision in *Graham v. John Deere Co.* (See *KSR int’l Co. V. Teleflex, Inc.* 127 S. Ct. 1727, 1739-40 (2007)). These and other representative rationales are described at MPEP § 2143 (8th Ed., Rev. 6, Sept. 2007). Regardless of the supporting rationale, however, the Patent Office must clearly articulate facts and reasons

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s filing date. (See *KSR Int’l Co. v. Teleflex, Inc.* 127 S. Ct. 1741). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness. In *re Kahn, et al.*, 441 F. 3d 977, 988 (Fed. Cir 2006). The key to supporting any rejection under 35 USC §103 is a clear articulation of the reasons why the claimed invention would have been obvious.

In a recent case regarding the appropriate standard for establishing obviousness, the Supreme Court stated:

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense is already known.” *KSR International Co. v. Teleflex, Inc.* 127 S. Ct. 1727, 1741 (2007) emphasis added

ii. Scope and Content of Prior Art

The rejected claims rely on a specific combination of an ethoxylated polymer, cross-linked polymer, particulate material and a lathering surfactant. By using a combination of ethoxylated polymers for thickening and cross-linked polymers for suspension in the present invention, one can obtain a product that is stable as well as lathers and rinses well.

The Date reference describes a skin care composition in the form of an oil-in-water dispersion. The composition comprises a silicon gum, a fatty acid ester and surfactants. The surfactants Date describes are used to emulsify oils and set up liquid crystalline systems. These surfactants are not "lathering surfactants".

The McKelvey reference describes a hair composition composed of cationic surfactants and fatty alcohols to form gel networks. Gel networks are a higher order structure than those of micelles in lathering systems. Gel networks are formed by heating non-lathering fatty materials in water which then swell to incorporate water in an ordered structure providing a viscous opaque structure. McKelvey further describes polymers that will not suspend materials in a micelle lathering system. McKelvey's polymers are known to thicken and not suspend, suspension being necessary in a micelle lathering system. McKelvey discloses and teaches the use of ethoxylated polymers, but does not teach the use of water soluble surfactants or lathering compositions.

iii. The Differences between the Claimed Invention and Prior Art

One of the differences between the subject matter recited in claim 1 and the disclosures in Date and McKelvey is that these references do not comprise lathering surfactant. Further, the action does not plausibly describe how this missing disclosure is otherwise taught by the art.

iv. The Rationales Purportedly Supporting a Prima Facie Case of Obviousness in the Action Do Not Apply

The action appears to support the §103(a) of all the pending claims by the rationale that all of features/elements recited in the claims were known in the prior art, and that the ordinarily skilled artisan could have combined those known features/elements, as claimed by known methods with no change in their respective functions to yield predictable results.

The Applicants respectfully submit that the action as a whole does not clearly articulate facts and reasons why the claimed invention "as a whole" would have been obvious to a hypothetical person having ordinary skill in the art at least as the claimed invention effective filing date. Specifically, the action does not articulate findings of fact relating to (1) the scope and content of the prior art, and (2) the difference between the

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

claimed invention and the prior art. Still further, while the action appears to rationale its conclusion of obviousness, the action does not articulate facts sufficient to support the asserted rationale. See MPEP 2143. The action, therefore, does not set forth a prima facie case of obviousness. Accordingly, the Applicants respectfully traverse the rejection, and request reconsideration and withdrawal of the rejection.

The Examiner has not identified a reason that would have prompted a person of ordinary skill in the relevant field to combine Date and McKelvey. To this end, a declaration of Timothy Coffindaffer, an inventor on the above identified application has been submitted with this response. Mr. Coffindaffer demonstrates in the declaration that each reference alone or in combination does not teach or suggest the present invention.

Mr. Coffindaffer states that none of the cited references, Date and McKelvey, teach or suggest the advantages and benefits of the combination of an ethoxylated polymer, cross-linked polymer, particulate material and a lathering surfactant used in the present invention. Both Date and Noveon do not disclose any information about lathering surfactants. Mr. Coffindaffer states that Date describes surfactants, ARLATONE 2121, are used to emulsify oils and set up liquid crystalline systems. These surfactants are not "lathering surfactants". Mr. Coffindaffer states that McKelvey discloses and teaches the use of ethoxylated polymers, but does not teach the use of water soluble surfactants or lathering compositions. Mr. Coffindaffer states that the McKelvey reference is a gel network system that are a higher order structure than those of micelles in lathering systems. Mr. Coffindaffer states that gel networks are formed by heating non-lathering fatty materials in water which then swell to incorporate water in an ordered structure providing a viscous opaque structure. McKelvey actually discloses the use of cationic surfactants. Special suspension polymers have been made to work with cationic surfactant systems that differ from those of anionic and lathering surfactant systems. Mr. Coffindaffer states that McKelvey further describes polymers that will not suspend materials in a micelle (lathering) system. Mr. Coffindaffer states that McKelvey's polymers are known to thicken and not suspend which is necessary in a micelle (lathering) system. Mr. Coffindaffer concludes that the combination of Date and McKelvey do not teach anything that would translate to an lathering surfactant system.

Thus, the combination of Date and McKelvey would not produce the composition of the present invention.

The action also appears to support the §103(a) rejection of all of the pending claims by the rationale that the skilled artisan would have been motivated to modify the Date patent to achieve the claimed invention and that there would have been a reasonable expectation of success. See Action page 7. Specifically, the action does not articulate any findings that there was some teaching suggestion or motivation, either in the Date patent or in the knowledge available to one of ordinary skill in the art, to modify the disclosure in the Date patent to arrive at the subject matter recited in claim 1. First of all Date teaches a composition with different physical properties than the composition of the present invention according to Mr. Coffindaffer. One skilled in the art would know that Date describes surfactants that are used to emulsify oils and set up liquid crystalline systems and that these surfactants are not "lathering surfactants". McKelvey actually discloses the use of cationic surfactants. One skilled in the art would know that McKelvey describes special suspension polymers that have been made to work with cationic surfactant systems that differ from those of anionic and lathering surfactant systems. Mr. Coffindaffer states that McKelvey further describes polymers that will not suspend materials in a micelle (lathering) system. Mr. Coffindaffer states that McKelvey's polymers are known to thicken and not suspend which is necessary in a micelle (lathering) system. Mr. Coffindaffer concludes that the combination of Date and McKelvey do not teach anything that would translate to an lathering surfactant system. The asserted rationale supporting the §103(a) rejection does not apply, however, absent such findings. See MPEP §2143(G).

Moreover, the mere fact that the Date patent's disclosure can be modified does not render the resultant modification obvious unless the result would have been predictable to the ordinarily skilled artisan. See *KSR Int'l S.Ct.* at 1740. Modifying the composition of Date from a leave-on moisturizer into a different physical form of lathering surfactant composition would be unexpected and unpredictable to one skilled in the art. As stated in the declaration of Mr. Coffindaffer, one of skill would never combine leave-on lotion technology with a lathering surfactant system as claimed in the present invention. The two systems do not mix. Materials used in moisturizers will typically render a lathering

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

system non-lathering and also destroy micelle structure. Mr. Coffindaffer concludes that the combination of Date and McKelvey, both gel networks, do not teach anything that would translate to a lathering surfactant system.

Additionally, the action does not articulate any finding that the ordinarily skilled artisan could have combined the elements, as claimed, by known methods, and that in combination each element merely performs the same function as it does separately. Specifically, the action does not articulate any finding that the ordinarily skilled artisan could have combined the composition of Date with the co-polymer of McKelvey to form the present invention. The action does not present any findings that co-polymer of McKelvey would perform the same function in the compositions of Date. In fact, Mr. Coffindaffer states that McKelvey describes polymers that will not suspend materials in a micelle (lathering) system. Mr. Coffindaffer states the declaration states that McKelvey's polymers are known to thicken and not suspend which is necessary in a micelle (lathering) system. Absent such findings, the asserted rationale supporting the §103(a) rejection does not apply.

Still further, the action does not articulate any finding demonstrating a reasonable expectation of success. Specifically, the action does not set forth any finding that a skilled artisan would have a reasonable expectation that reformulating the leave-on moisturizer of Date with the co-polymer of McKelvey would not create the presently claimed composition as recited in claim 1. As stated in the Declaration of Mr. Coffindaffer, there would be no expectation of success. The asserted rationale supporting the §103(a) rejection does not apply, however, absent such findings.

Accordingly, the rejection is traversed, and the reconsideration and withdrawal of the rejection are respectfully requested.

Therefore, the Applicants respectfully disagree that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cite references to result in the compositions of the present invention. Thus, the Applicants respectfully submit that the rejection should accordingly be withdrawn.

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

c. Rejection Under 35 USC §103(a) Over Date in view of Fair et al.(U.S. Patent No. 5,869,441(hereinafter referred to as "Fair")).

Claims 1 and 15-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Date in view of Fair.

The Office Action states that Date teaches the skin care composition. The Office Action states that Date does not exemplify the lather volume of the composition or the ratio of anionic surfactants to amphoteric/zwitterionic surfactants from about 1.5:1 to about 1:3. The Office Action states that Fair teaches compositions that increase the lather through the use of anionic and zwitterionic lathering surfactants. The Office Action states that Fair does not claim the instant claimed ratios. The Office Action states that it is the opinion of the Examiner that it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable ratios of anionic and amphoteric/zwitterionic surfactants through routine and manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art. The Office Action states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a foaming cleaning composition that comprises anionic and amphoteric/zwitterionic lathering surfactants, as taught by Date in view of Fair. One of ordinary skill in the art at the time the invention was made would have been motivated to combine these elements into a single composition because of the benefits of increasing the later in a skin cleaning composition of both the anionic and amphoteric/zwitterionic surfactants taught by Fair. The Office Action concludes that absent any evidence to the contrary and based on the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention.

i. Proper Basis for §103(a) Rejection

The patent statute states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if such difference between the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

art to which said subject matter pertains. Patentability shall be not negated by the manner in which the invention was made. 35 USC §103(a)

A determination that a claim is obvious under §103(a) is a legal conclusion involving four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, or non-obviousness. *Graham v. John Deere Co.* 383 U.S. 1, 17-18 (1966). Secondary considerations of obviousness include factors such as commercial success, long-felt but unresolved needs, the failure of others, and/or unexpected results achieved by the claimed invention. *Id.* Furthermore, obviousness must be determined as of the time the invention was made and in view of the state of the art that existed at the time. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F. 2d 1044, 1050-51 (Fed. Cir 1988).

The Patent Office “has the burden under §103 to establish a prima facie case of obviousness.” *In re Fine*, 837 F. 2d 1071 1074 (Fed. Cir. 1988); MPEP §2142 (8th Ed. Rev. 6, Sept. 2007) (“the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.”). The Supreme Court recently identified a number of rationales that may be used to support a conclusion of obviousness, consistent with the framework set forth in its decision in *Graham v. John Deere Co.* (See *KSR int’l Co. V. Teleflex, Inc.* 127 S. Ct. 1727, 1739-40 (2007)). These and other representative rationales are described at MPEP § 2143 (8th Ed., Rev. 6, Sept. 2007). Regardless of the supporting rationale, however, the Patent Office must clearly articulate facts and reasons why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s filing date. (See *KSR Int’l Co. v. Teleflex, Inc.* 127 S. Ct. 1741). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness. *In re Kahn, et al.*, 441 F. 3d 977, 988 (Fed. Cir 2006). The key to supporting any rejection under 35 USC §103 is a clear articulation of the reasons why the claimed invention would have been obvious.

In a recent case regarding the appropriate standard for establishing obviousness, the Supreme Court stated:

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense is already known.”
KSR International Co. v. Teleflex, Inc. 127 S. Ct. 1727, 1741 (2007)
emphasis added

ii. Scope and Content of Prior Art

The rejected claims rely on a specific combination of an ethoxylated polymer, cross-linked polymer, particulate material and a lathering surfactant. By using a combination of ethoxylated polymers for thickening and cross-linked polymers for suspension in the present invention, one can obtain a product that is stable as well as lathers and rinses well.

The Date reference describes a skin care composition in the form of an oil-in-water dispersion. The composition comprises a silcon gum, a fatty acid ester and surfactants. The surfactants Date describes are used to emulsify oils and set up liquid crystalline systems. These surfactants are not “lathering surfactants”.

The Fair reference describes a bar soap composition. Bar Soaps are solid non-flowable materials until they have been taken above the melt point. Bar soaps do not require any type of suspension system at all and insoluble materials are just incorporated into the matrix. When water is added with friction (e.g. rubbing the bar in the hands), the solid surfactants are slowly solublized into the water and can release insoluble materials.

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

Fair's bar soaps are composed of solid surfactants and only have 5% water in their composition. The Fair reference describes the mildness advantages for hydrophobically modified ethylenediaminetriacetic acid surfactants which are a new surfactant. Fair actually teaches the need for both anionic and amphoteric surfactants and hydrophobically modified ethylenediaminetriacetic acid surfactant. And Fair describes that it does not lather as well as typical anionic surfactants. According to Fair, "by adding relative low levels of SLES, and Cocamidopropyl betaine as coactives to the Na-LED3A solution, the lather performance is greatly improved". SLES is anionic and Cocamidopropyl betaine is amphoteric and these system by themselves will lather well. Many mild surfactants as claimed by Fair with Na-LED3A have very poor lathering profiles.

iii. The Differences between the Claimed Invention and Prior Art

One of the differences between the subject matter recited in claim 1 and the disclosures in Date and Fair does not comprise lathering surfactants. Further, the action does not plausibly describe how this missing disclosure is otherwise taught by the art.

iv. The Rationales Purportedly Supporting a Prima Facie Case of Obviousness in the Action Do Not Apply

The action appears to support the §103(a) of all the pending claims by the rationale that all of features/elements recited in the claims were known in the prior art, and that the ordinarily skilled artisan could have combined those known features/elements, as claimed by known methods with no change in their respective functions to yield predictable results.

The Applicants respectfully submit that the action as a whole does not clearly articulate facts and reasons why the claimed invention "as a whole" would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention effective filing date. Specifically, the action does not articulate findings of fact relating to (1) the scope and content of the prior art, and (2) the difference between the claimed invention and the prior art. Still further, while the action appears to rationale its conclusion of obviousness, the action does not articulate facts sufficient to support the

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

asserted rationale. See MPEP 2143. The action, therefore, does not set forth a prima facie case of obviousness. Accordingly, the Applicants respectfully traverse the rejection, and request reconsideration and withdrawal of the rejection.

The Examiner has not identified a reason that would have prompted a person of ordinary skill in the relevant field to combine Date and Fair. To this end, a declaration of Timothy Coffindaffer, an inventor on the above identified application has been submitted with this response. Mr. Coffindaffer demonstrates in the declaration that each reference alone or in combination does not teach or suggest the present invention.

Mr. Coffindaffer states that none of the cited references, Date and Fair, teach or suggest the advantages and benefits of the combination of an ethoxylated polymer, cross-linked polymer, particulate material and a lathering surfactant used in the present invention. Date does not disclose any information about lathering surfactants. Mr. Coffindaffer states that Date describes surfactants, ARLATONE 2121, are used to emulsify oils and set up liquid crystalline systems. These surfactants are not "lathering surfactants". Fair actually teaches the need for both anionic and amphoteric surfactants to the hydrophobically modified ethylenediaminetriacetic acid surfactant describing that it does not lather as well as typical anionic surfactants. According to Fair, "by adding relative low levels of SLES, and Cocamidopropyl betaine as coactives to the Na-LED3A solution, the lather performance is greatly improved". SLES is anionic and Cocamidopropyl betaine is amphoteric and these system by themselves will lather well. Many mild surfactants as claimed by Fair with Na-LED3A have very poor lathering profiles. Fair's bar soaps are composed of solid surfactants and only have 5% water in their composition. Bar Soaps are solid non-flowable materials until they have been taken above the melt point. Bar soaps do not require any type of suspension system at all and insoluble materials are just incorporated into the matrix. When water is added with friction (e.g. rubbing the bar in the hands), the solid surfactants are slowly solubilized into the water and can release insoluble materials. Mr. Coffindaffer concludes that given that Date is a leave-on moisturizer and Fair is a bar soap, one skilled in the art would not combine the references. Thus, the combination of Date and McKelvey would not produce the composition of the present invention.

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

The action also appears to support the §103(a) rejection of all of the pending claims by the rationale that the skilled artisan would have been motivated to modify the Date patent to achieve the claimed invention and that there would have been a reasonable expectation of success. See Action page 7. Specifically, the action does not articulate any findings that there was some teaching suggestion or motivation, either in the Date patent or in the knowledge available to one of ordinary skill in the art, to modify the disclosure in the Date patent to arrive at the subject matter recited in claim 1. First of all Date teaches a composition with different physical properties than the composition of the present invention according to Mr. Coffindaffer. One skilled in the art would know that Date describes surfactants that are used to emulsify oils and set up liquid crystalline systems and that these surfactants are not “lathering surfactants”. One skilled in the art would know that Fair describes solid surfactants that lather poorly and are not “lathering surfactants”. As well, Fair teaches a composition with different physical properties than the composition of the present invention according to Mr. Coffindaffer. Mr. Coffindaffer concludes that given that Date is a leave-on moisturizer and Fair is a bar soap, one skilled in the art would not combine the references. The asserted rationale supporting the §103(a) rejection does not apply, however, absent such findings. See MPEP §2143(G).

Moreover, the mere fact that the Date patent’s disclosure can be modified does not render the resultant modification obvious unless the result would have been predictable to the ordinarily skilled artisan. See *KSR Int’l S.Ct.* at 1740. Modifying the composition of Date from a leave-on moisturizer into a different physical form of lathering surfactant composition would be unexpected and unpredictable to one skilled in the art. As stated in the declaration of Mr. Coffindaffer, one of skill would never combine leave-on lotion technology with a lathering surfactant system. The two do not mix. Materials used in moisturizers will typically render a lathering system non-lathering and also destroy micelle structure. Moreover, Mr. Coffindaffer concludes that given that Date is a leave-on moisturizer and Fair is a bar soap, one skilled in the art would not combine the references.

Additionally, the action does not articulate any finding that the ordinarily skilled artisan could have combined the elements, as claimed, by known methods, and that in combination each element merely performs the same function as it does separately. Specifically, the action does not articulate any finding that the ordinarily skilled artisan could have combined the composition of Date with the co-polymer of McKelvey to form

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

the present invention. The action does not present any findings that surfactants of Fair would perform the same function in the compositions of Date. In fact, Fair actually teaches Fair's bar soaps are composed of solid surfactants and only have 5% water in their composition. Bar Soaps are solid non-flowable materials until they have been taken above the melt point. In fact, Mr. Coffindaffer states that bar soaps do not require any type of suspension system at all and insoluble materials are just incorporated into the matrix. Moreover, Mr. Coffindaffer concludes that given that Date is a leave-on moisturizer and Fair is a bar soap, one skilled in the art would not combine the references. Absent such findings, the asserted rationale supporting the §103(a) rejection does not apply.

Still further, the action does not articulate any finding demonstrating a reasonable expectation of success. Specifically, the action does not set forth any finding that a skilled artisan would have a reasonable expectation that reformulating the leave-on moisturizer of Date with the co-polymer of McKelvey would not create composition as recited in claim 1. As stated in the Declaration of Mr. Coffindaffer, there would be no expectation of success. The asserted rationale supporting the §103(a) rejection does not apply, however, absent such findings.

Accordingly, the rejection is traversed, and the reconsideration and withdrawal of the rejection are respectfully requested.

Therefore, the Applicants respectfully disagree that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cite references to result in the compositions of the present invention. Thus, the Applicants respectfully submit that the rejection should accordingly be withdrawn.

Application No. 10/797,981
Docket No. 9576
Amendment dated June 18, 2008
Reply to Office Action mailed on March 27, 2008
Customer No. 27752

VI. Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied reference(s). In view of the foregoing, reconsideration of this application, and allowance of the pending claim(s) are respectfully requested.

Respectfully submitted,

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